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PATENT

CERTIFICATE OF MAILING PURSUANT TO 37 CFR § 1.8

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9/21/06

Mehelle Hobson

Date

Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

JAMIESON et al.

Serial No.: 10/055,713

Filing Date: January 22, 2002

Title: ZINC FINGER PROTEINS FOR DNA BINDING
AND GENE REGULATION IN PLANTS

Examiner: C. Collins

Group Art Unit: 1638

Confirmation No.: 6239

Customer No.: 20855

PETITION FROM RESTRICTION REQUIREMENT UNDER 37 C.F.R. § 1.144

Commissioner for Patents
Mail Stop: PETITION
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. § 1.144, Applicants petition the Restriction Requirement in the above-referenced case. The Restriction Requirement is not supported by sound reasoning and should be withdrawn.

Restriction Requirements

The first Restriction Requirement in the above-referenced case was mailed on June 20, 2003 (copy attached hereto) and required election of one of eleven allegedly distinct groups of claims. Applicants traversed the first Restriction Requirement in a response filed July 11, 2003. In an Office Action mailed on October 6, 2003, the Restriction Requirement was withdrawn and

all pending claims were examined. (Page 2 of Office Action mailed October 6, 2003, copy attached hereto).

A second Restriction Requirement was mailed on May 5, 2005 and required election of one of 18 allegedly distinct groups of claims. All 18 groups included all the claims as pending (claims 1-4, 6-11, 14, 17-19 and 21-23). Thus, the second Restriction Requirement, which is petitioned by virtue of this paper, is based on the assertion the functional domains set forth in dependent claims 14 and 33 are independent and distinct from each other.

Applicants' Traversal

Applicants filed a Response to the second (petitioned) Restriction Requirement on June 9, 2005. In their response, Applicants elected Group IX with traverse and requested reconsideration. Applicants traversed on the grounds that : (1) the Examiner had not shown the 18 groups were independent and distinct, and (2) that it would not be unduly burdensome to search all functional domains together. *See*, Response to Restriction Requirement, mailed June 9, 2005, copy attached hereto.

With respect to the first point, Applicants noted that the Restriction was improperly based on limitations (type of functional domain) recited in two dependent claims, and no reasons for independence and distinctness of independent claims 1 and 21 were provided by the Office. Indeed, Applicants pointed out that the Examiner acknowledged that independent claims 1 and 21 are not patentably distinct from each other, as they were classified in all of the 18 allegedly distinct Groups.

Applicants also traversed on the grounds that Restriction between members of a Markush group is improper, as is an election of species requirement when the members of a Markush group are closely related. *See*, Response to Office Action dated February 27, 2006, citing M.P.E.P. § 803.02, which states that restriction between related members of a Markush group is improper (emphasis added):

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they may be directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require provisional election of a single species.

With regard to the second point (search burden), Applicants traversed on the grounds that any search for references relevant to the subject matter of independent claims 1 and 21 (classified in all 18 Groups) would **necessarily and in all cases** reveal art relevant to all claims, including modified plant zinc finger proteins comprising the various functional domains recited in dependent claims 14 and 33, which form the basis of the Restriction. Furthermore, Applicants noted that a search for all functional domains was not required because these domains are not claimed independently of their association with a modified plant ZFP. Thus, the proper search for the pending claims is a search for references relevant to modified plant ZFPs, as set forth in claims 1 and 21.

Applicants also traversed because the necessary search for references relevant to modified ZFPs had already been conducted, as evidenced by the substantive examination in this case that preceded the filing of the RCE on June 7, 2004. In particular, as noted above, the first Restriction Requirement was withdrawn and all claims (including claim 14, which recited functional domains) were searched and examined together. Therefore, Applicants argued that not only did the various functional domains not need to be searched separately; the proper and relevant search for the subject matter of the independent claims had already been conducted.

Finality of Restriction Requirement

In an Office Action mailed August 25, 2005, the second Restriction Requirement was made FINAL. In response to Applicants' arguments in support of traversal, the Examiner stated that (1) the functional domains of the dependent claims are distinct "because they originate from different species of organisms and because they differ structurally and functionally" and (2) the "various functional domains must be searched separately from their association with a modified plant ZFP even though they are not claimed independently." (Office Action mailed August 25, 2005, pages 3 and 4, copy attached hereto).

Petition

The Examiner's reply to Applicants' traversal of the Restriction Requirement states that the functional domains are distinct because they differ structurally and functionally and because a search of all Groups would require searching for each functional domain set forth in claims 14

and 33 separately. Applicants respectfully assert that the Examiner has failed to provide adequate reasoning to support these statements.

1. Distinctness of Functional Domains Has Not Been Established

The Examiner has not established that the functional domains of dependent claims 14 and 33 differ in structure or function.

By definition, the functional domains of each of the allegedly different Groups do not differ functionally – they all act to modulate transcription. Thus, functional domains derived from different organisms have not been shown to be distinct and independent, as required to support the Restriction Requirement.

Furthermore, adequate reasoning has not been presented to show that these functional domains differ “structurally.” Indeed, in the rejection under 35 U.S.C. § 102 made in the Final Office Action mailed May 16, 2006, the Examiner states that all zinc finger proteins have the “same chemical composition, *i.e.*, they are composed of amino acids.” (Page 7 of Final Office Action, mailed May 16, 2006, copy attached hereto). In other words, the Examiner defines the common structure of zinc finger proteins to be their amino acid composition. Likewise, all functional domains set forth in claims 14 and 33 share a common structural feature as defined by the Examiner (*i.e.*, they are all composed of amino acids), which common structure is related to their utility as transcriptional regulators.

Therefore, according to the criteria established by the Examiner, the functional domains do not differ in function or structure. Accordingly, the Restriction is improper and should be withdrawn.

2. Searching All Functional Domains Together is Not Unduly Burdensome AND the Search Has Already Been Conducted

Moreover, the Examiner has failed to provide adequate reasoning to support the assertion that “various functional domains” must be searched separately. As repeatedly pointed out by Applicants, a search of the art for a protein comprising any modified plant zinc finger protein (as recited in claims 1 and 21) would necessarily and inevitably reveal all such proteins containing

attached functional domains. *See, e.g.*, Response to Office Action dated February 27, 2006, reproduced in part above.


Applicants also reiterate that still further evidence as to the lack of search burden is the fact that the first Restriction Requirement (mailed June 20, 2003) did not distinguish among functional domains and, moreover, was withdrawn, resulting in all claims (and, accordingly, all functional domains) being searched and examined. *See*, Restriction Requirement mailed June 20, 2003 and page 2 of Office Action October 6, 2003, copies attached hereto. Thus, the Examiner has **already searched all** functional domains and applied the references found in her search in Office Actions dated October 6, 2003 and March 8, 2004.

3. Conclusion

For the aforementioned reasons, Applicants petition for review by the Director and request that the Restriction Requirement be withdrawn, and that Groups I to XVIII be rejoined and examined together.

Respectfully submitted,

Date: September 21, 2006

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Art Unit: 1638



DETAILED ACTION

Election/Restrictions

COPY

Applicant's election with traverse of Group X, filed July 14, 2003, is acknowledged.

Upon further consideration the restriction requirement is withdrawn. Claims 1-19 are examined in the instant office action.

Information Disclosure Statement

An initialed and dated copy of Applicant's IDS form 1449, filed December 30, 2002 is attached to the instant Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are broadly drawn to isolated polynucleotides encoding plant zinc finger proteins of undefined structure and unknown modification that bind to undefined target sequences of any size and any nature, including such isolated polynucleotides that further encode a domain of undefined structure and function that may repress or activate some unknown



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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Sir:

This paper is responsive to the Restriction Requirement mailed May 10, 2005, for which a response is initially due on or before June 10, 2005. Accordingly, this response is timely filed.

Remarks begin on page 2 of this paper.